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10/735,854	12/16/2003	Robert Frigg	10139/13801	3166

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/735,854
Filing Date: December 16, 2003
Appellant(s): FRIGG, ROBERT

Oleg F. Kaplun
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 16th, 2008 appealing from the Office action mailed October 17th, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the

specification by page and line number, and to the drawing, if any, by reference characters.

The brief is deficient because it fails to correctly and concisely explain the subject matter defined in the independent claim. Applicant cites only the specification at **page 8, lines 11-14 and Figure 2** as relevant to the recitation of "pins that are pivot-mounted in the first member." As described in previous Actions, due to claim 7 reciting "elastic deformation" (support given at **Page 3, Lines 11-14** stating that a unitary structure of the inner and outer annular elements, the connecting members and the implant can be capable of exhibiting elastic deformation to permit the annular element to swivel), applicant's characterization is inconsistent with applicant's own claims (stated as readable on the elected species as recent as July 27th, 2007). Therefore, the "pins" may or may not be physically separate from the first and second member.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

The rejection of claim 7 under 35 U.S.C. 112, 1st paragraph is not presented for review on appeal because it has been withdrawn by the examiner.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,029,091	von Bezold et al	06-1977

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7, 13-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by von Bezold et al (US Patent 4,029,091).

von Bezold et al disclose an implant (**Figures 1-6**) comprising: at least one coupler (**14**) with two connecting elements (**18a and 18b**); the connecting elements allow a screw to rotate with respect to the implant (the bone plate **10'**); the connecting elements extend from an outer perimeter of the coupler roughly 180 degrees apart; the plate and coupler both have a hole (**12**) for receiving the bone screw; and the bone plate has a thickness larger than a thickness of a coupler (see **Figure 3**, a portion of **14** is tapered and thus has a thickness less than the plate **10'**).

(10) Response to Argument

Applicant continues to contend that the device of von Bezold et al is does not disclose "a coupler having at least two connecting elements for engaging a first member to a second member," the connecting elements permitting the first member to rotate with respect to the second member and "wherein the connecting elements are pins that are pivot-mounted in the first member."

This contention is supported by repeatedly pointing the lack of pivoting/rotation of the "lugs 14." This is not found persuasive because as clearly stated in **Column 1, Lines 52-62**, the rod-like (pin) connection or cantilever element **18** has a width (measured in the longitudinal direction of the plate) such that it can act as a resilient cantilever having a predetermined degree of stiffness and resiliency.

Applicant attempts to use this statement to prove that the structure is incapable of allowing a rotation/pivoting action as well as the lateral displacement. From quick reference to the **Figures of 1-3** for example of von Bezold et al, if the material of choice is capable of lateral displacement of **14** along the longitudinal axis of the plate, how would the same material given the longer length dimensions (where 18a/b connects completely with plate **10'** to connecting with lug **14** in **Figure 2**) or thinner thickness (**Figure 3**) not allow a pivoting movement of lug **14** (as well as the screw located within it) relative to the plate (**10'**)?

The examiner agrees that that if the bone plate was fixed to bone, either limited or no pivoting action would be capable if the fit was perfectly flush as found in **Figure 3**. However, such a limitation is not found within the claims which is why previously it was explained that when the plate was not fixed to bone, that a fastener or lug **14** would be capable of pivoting/rotating relative to the plate. Applicant then seems confused with this argument stating that the fastener is only partially located within the lug **14** and that only the lug potentially flexes relative to the plate when turning the screw. None of this is what is required by the claim. All that is required is one member rotating/pivoting relative to another member. The screw can be partially or completely located within the lug **14**

and does not need the action to pivot/rotate directly applied to it. The force to rotate the members could be placed at any given point or across the whole connecting element should one desire clearly causing a pivoting/rotation as claimed.

Therefore, it is felt clear from the disclosure (written specification and Figures) of von Bezold et al that the rod-like connecting elements/cantilevers are capable of pivoting/rotating the lug/screw relative to the plate due to the stated ability to translate when fixed to bone thereby demonstrating a resilient structure. This structure would only be partially or completely prevented from moving in a pivoting/rotational manner due to flush components (bone plate/lug flush with the bone as seen in **Figure 3**) which is not recited in the claimed invention and therefore irrelevant when considering the device not engaged with bone. When not engaged with bone, the lug/connecting element/screw are all freely movable to pivot/rotate as well as the lateral displacement along the longitudinal direction of the plate.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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